

REMARKS

This paper responds to an Office Action dated March 24, 2003, which was a Final Action. Since this paper is filed within two months of the Office Action, Applicant requests an Advisory Action.

Claim Rejections Under 35 USC §§102(e)/103

The Office Action rejected claims 1-6 and 10-14 under 35 USC § 103(a) as unpatentable over U.S. Patent 6,381,256 (Stamm) in view of another document. In an amendment filed November 26, 2002, Applicant argued that Stamm is not a proper §102(e)/103 reference because the present application and the Stamm patent are commonly owned, and thus §103(c) applies. The Office Action disagreed, and cited a flowchart that deals with determining dates for §102(e) references.

This paper reiterates Applicant's argument that §103(c) removes Stamm as a reference. The statute provides:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicant's November 26, 2002 amendment established that the Stamm patent and the present application are commonly owned. The Office Action does not dispute this fact, but, nevertheless, refuses to follow §103(c).

The Office Action apparently holds that §103(c) does not apply in this case because the Stamm patent has an effective date of February 10, 1999 for purposes of §102(e). The Office Action refers to a flowchart for establishing §102(e) dates, and highlights a box that reads, in part, "The §102(e) date of the reference is the earliest U.S. filing date for which a benefit is properly sought via §§ 119(e) and/or 120." The §102(e) date of Stamm, however, is irrelevant to the issue of whether §103(c) applies.

What is relevant is that the filing date of the present application is after November 29, 1999, the effective date of an amendment to §103(c). The present application was filed on February 24, 2000, after the effective date. MPEP § 706.02(l)(1) provides:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues. [Emphasis added].

Since the present application was filed after November 29, 1999, §103(c) removes as prior art any §102(e) reference, including Stamm, that is commonly owned.

The filing date of the present application is after November 29, 1999 despite the fact that it claims priority to a provisional application filed before November 29, 1999. The provisional application was filed February 26, 1999, but claiming domestic priority is irrelevant to obtaining a filing date of February 24, 2000 for the subject nonprovisional application. According to 37 CFR 1.53 (b),

Application filing requirements - Nonprovisional application. The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office.

### Summary

The basic facts are these: (1) The filing date of the present application is February 24, 2000. (2) The present application and the Stamm patent are commonly owned.

The conclusion of law that must follow from these facts is that 35 USC §103(c) prohibits the use of Stamm in a rejection under 35 USC §103(a). Since this is the only grounds for maintaining the rejection of claims 1-6 and 10-14, the rejection must be withdrawn.

**Conclusion**

For all the reasons set forth above, Applicant requests reconsideration and withdrawal of the rejections stated in the March 24, 2003 Office Action.

Respectfully submitted,

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